Appl. No. 10/789,971 Amdt. Dated 8-8-06 Reply to Office Action of 4-20-06

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application. Claims 1-11 have been canceled. Independent claim 12 has been amended to overcome the prior art rejections. No new matter has been introduced.

Amended Claims are Patentable

Applicant respectfully submits the following newly claimed recitations clearly place the present invention in condition for allowance.

Applicant has amended the claims to more narrowly distinguish the present invention over the prior art of record. Applicant respectfully submits no new matter has been introduced, which would affect the statutory requirements of patentability, because all newly claimed recitations are clearly supported by the original drawings. A person of ordinary skill in the art is enabled to make and use the presently claimed invention based on the originally filed drawings. Applicant has included case law, wherein the Court has held the claims may be amended based upon the originally filed drawings without triggering a new matter rejection (please see attached literature).

• a base member having an annular shape with a predetermined diameter and further having a substantially planar top surface, said base member being positioned below a ground surface with said top surface disposed at a substantially horizontal position, said base member including a centrally registered protrusion connected to said top surface and extending upwardly therefrom in a substantially vertical direction. Hall's base member necessarily sits above a ground surface, as shown in FIG. 2. Hall's protrusion (as defined by the examiner) is not centrally registered, as claimed by the applicant. Hall's protrusion necessarily extends along an inner perimeter of respective blocks 5, as shown in FIGS. 1 and 2, and not centrally registered therewith. Please note, the examiner has mischaracterized the Hall reference by defining reference 14 as two separate elements, i.e. the protrusion and the engaging portion (see page of the examiner's office action). Such a characterization is improper per the MPEP.

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- said protrusion having a centrally registered bottom face directly coupled to said
 top surface of said base member, said protrusion further having an annular top face
 provided with a diameter smaller than a diameter of said bottom face respectively.
 Such claim recitations are critical and inherently necessary for applicant's blocks to
 securely hold each other in place. Hall necessarily cannot employ such a protrusion
 because post 22 is inherently a necessary and critical part of its invention which passes
 along a central longitudinal axis of blocks 5. Therefore, one skilled in the art would
 know that Hall cannot employ applicant's claimed protrusion.
- said engaging portions extending upwardly from a top surface of each of said ancillary members and being centrally registered with respective central longitudinal axes thereof, said receiving portions extending upwardly from a bottom surface of each of said ancillary members and being centrally registered with the central longitudinal axes thereof respectively, said receiving portions terminating subjacent to said engaging portions such that a major central region of each of said ancillary members defines a solid core formed from a rigid substance. Hall's engaging and receiving portions 14, 15 (as defined by the examiner) are not centrally registered, as claimed by the applicant. Hall necessarily and critically requires centrally offset engaging and receiving portions because post 22 must centrally pass through a center of the blocks 5. Please note, the examiner has mischaracterized the Hall reference by defining reference 14 as two separate elements, i.e. the protrusion and the engaging portion (see page of the examiner's office action). Such a characterization is improper per the MPEP.
- wherein said square first portion and said rectangular portion have respective longitudinal lengths greater than respective widths thereof such that the above-ground structure is effectively maintained at a substantially stable position and prohibited from disengaging said top member during inclement weather conditions. Such a claimed recitation is essential and critically necessary for applicant's claimed invention to adequately support the above-ground post within said top member. If applicant's square first portion and rectangular portion were shallow, as taught by McCoy, one skilled in the art would know that applicant's above-ground structure would be susceptible to prematurely detaching from the top member. Moreover, there is no

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teaching, suggestion or motivation to combine McCoy's teachings with Hall's teachings. Hall simply has no need for applicant's claimed square first portion and rectangular portion because it is intended to be employed below water level and will necessarily remain wet during operating conditions (see column 1, lines 9-15). Therefore, one skilled in the art would understand that it is counter intuitive and unnecessary to combine McCoy's teachings with Hall's teaching to drain fluids away from the blocks 5, when they are submerged under water.

In view of these considerations, it is respectfully submitted that the rejection of the pending claims should be considered as no longer tenable with respect to the above mentioned arguments and claim amendments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Patent Prosecution

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for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the latter are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.492

The CCPA remarked that the originally filed specification described the step of applying the adhesive as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums."493 The specification thus described one method of adheringly applying the various layers in the thermal insulation. On the basis of this description, the CCPA held that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant how the layers are adhered, so long as they are adhered. Thus the phrase 'adheringly applying' is supported by the example found in the specification."494

Rasmussen therefore teaches that an original claim and examples in the specification may be used to support amendments after the application is filed.

C. Drawings That Provide Support for Amendments to Specification

Drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. In re Wolfensperger 495 is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In Wolfensperger, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a "packing ring" in "untensioned condition" that included "a mean diameter corresponding approximately to the mean diameter of

On appeal, the CCPA reversed. The court disagreed with the Board's statement that it was well-established legal precedent that

said chamber."496

⁴⁷Id., 211 USPQ at 326 n.5 (citing *In re* Anderson, 471 F.2d 1237, 1238, 176 USPQ 331, 232 (C.C.P.A. 1973)),

^{441/}d., 211 USPQ at 826.

^{ca}Id., 211 USPQ at 327 (footnote omitted) (emphasis in original).

⁴⁸⁶In re Wolfensperger, 302 P.2d 950, 133 USPQ 587 (C.C.P.A. 1962).

⁴⁴⁶ Jd., 133 USPQ at 538.

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Disclosure

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drawings alone cannot constitute a written description of the invention. The CCPA stated as follows in this connection:

Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case. 497

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."

The CCPA held that figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber. On this basis, the court held that the application satisfied the written description requirement. Thus, Wolfensperger teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.



D. New Matter and Correcting Obvious Errors

An applicant may generally correct obvious errors in the application without introducing prohibitory new matter. For example, translation errors from foreign prior applications may generally be corrected. The general rule is that if the error can be detected and corrected by one of ordinary skill in the art, then the applicant may amend the application to correct the error without introducing new matter. 501

Ex parte Brodbeck⁵⁰² is an example of when an applicant was permitted to amend the specification to correct an obvious error. In Brodbeck, the invention related to a process of catalytic isomerization of a compound. Brodbeck sought to reissue his already-granted patent, U.S. Patent Number 3,647,898, by amending the claim portion of the application. The original claim 1 of the issued patent recited the lim-

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⁴⁹ Id., 133 USPQ at 541-42.

^{#9/}d., 133 USPQ at 542 (emphasis in original).

⁴⁹¹d., 133 USPQ at 541.

soc See In re Oda, 443 F.2d 1200, 170 USPQ 268, 272 (C.C.P.A. 1971).

MId.

mEx parts Brodbeck, 199 USPQ 230 (Pat. Off. Bd. . . p. 1977).